

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

JAN. 26, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Marilyn Jean Edwards and Elizabeth Ann Glazner (joint
applicants)

Serial No. 74/556,186

William J. Brucker of Stetina, Brunda, Garred & Brucker for
Marilyn Jean Edwards and Elizabeth Ann Glazner (joint
applicants).

Susan J. Kastriner, Trademark Examining Attorney, Law
Office 107 (Thomas Lamone, Managing Attorney)

Before Hanak, Chapman and Wendel, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

On August 2, 1994 Marilyn Jean Edwards and Elizabeth
Ann Glazner filed an intent-to-use application seeking to
register WAHINE MAGAZINE in typed capital letters for
"magazines for women in the field of water athletics,
namely surfing, and including health and beauty
information." For ease of reference, these joint

applicants will be referred to as simply "applicant." The applicant disclaimed the exclusive right to use MAGAZINE apart from the mark in its entirety.

In the first Office action, the Examining Attorney refused registration pursuant to Section 2(e)(1) of the Lanham Trademark Act "because the mark merely identifies the primary audience for the publication." The Examining Attorney stated that "the term 'wahine' is defined ... as 'a woman surfer.'" It should be noted that in this first Office action and at no time thereafter did the Examining Attorney object to applicant's original identification of goods.

In response, applicant submitted the declaration of its counsel (William J. Brucker) who stated that he conducted a NEXIS search of the word "wahine." Continuing, Mr. Brucker stated that when stories relating "to the Rainbow Wahine Women's Basketball Team of the University of Hawaii or the Annual Women's Basketball Tournament known as the Rainbow Wahine Classic" were excluded, there were 128 stories remaining. Mr. Brucker went on to note in his response that of the 128 stories, only one arguably referred to a woman surfer."

In addition, applicant sought to amend its identification of goods to read as follows: "Athletics,

health and beauty magazines for women in the field of water athletics, primarily, surfing, bodyboarding, swimming, diving, bodysurfing, sailing, windsurfing, skimboarding, outrigger canoes, kayaking, river rafting, beach volleyball and related beach culture."

In the second Office action, the Examining Attorney continued her mere descriptiveness refusal and in addition stated that the proposed amended identification of goods was not acceptable in that it included subject matter that was not "within the scope of the identification that was set forth in the application at the time of filing."

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

At the outset, we note that the word "wahine" receives varied treatment by different dictionaries. Some dictionaries do not have any listing for this term. See, for example, The American College Dictionary (Random House, 1970) and The American Century Dictionary (Oxford University Press, 1995). Other dictionaries have one meaning for the word "wahine." In Webster's New World Dictionary (2d ed. 1970) that meaning is as follows: "[Maori & Haw.] a Polynesian woman. esp. of Hawaii." In

Webster's New World College Dictionary (1997) the meaning is essentially the same, namely: "[Haw or Maori, woman: for Proto-Polynesian form see vahine] A Polynesian woman, esp. of Hawaii." See also Hawaiian Dictionary (1986). Finally, the Examining Attorney has made of record photocopies of the pertinent pages from three dictionaries which contain two definitions for the word "wahine." In The American Heritage Dictionary, said word is defined as follows: "1. A Polynesian woman. 2. A female surfer. [Hawaiian and Maori]." In Webster's II New Riverside University Dictionary, the word "wahine" is defined as follows: "[Hawaiian and Maori] 1. Polynesian woman. 2. A woman surfer." In Random House Unabridged Dictionary, the word "wahine" is defined as: "1. (in Hawaii and Polynesia) a girl or young woman. 2. Slang. A woman surfer."

It is the contention of the Examining Attorney that it is this second definition of the word "wahine" contained in three dictionaries which causes applicant's mark WAHINE MAGAZINE to be merely descriptive in that it "clearly identifies the subject matter of the applicant's publication," namely, "a female surfer" or a "woman surfer." The Examining Attorney does not contend that the first definition of the "wahine" contained in the three dictionaries which she referenced (i.e. Polynesian woman or

young woman) would cause applicant's mark to be descriptive of its publication. (Examining Attorney's brief page 9).

We find that "woman surfer" is an obscure meaning of the word "wahine." The majority of dictionaries either do not contain any listing for the word "wahine," or if they do contain a listing, said word is defined simply as "a Polynesian woman." The meaning of the word "wahine" which the Examining Attorney contends causes applicant's mark WAHINE MAGAZINE to be merely descriptive (i.e. woman surfer) is a secondary definition which is found in only three dictionaries of record. More importantly, in reviewing the over 125 NEXIS stories made of record, we find that, at most, only one of these stories arguably utilizes the word "wahine" to mean "woman surfer." All of the other NEXIS articles made of record use the term "wahine" to refer to women or Polynesian women, or they use it in manners which are totally unrelated to applicant's goods, such as a surname (i.e. the former governor of Hawaii, John Wahine) or the name of a ship.

If a word has a meaning which is descriptive of applicant's goods or services, but that meaning is obscure, then said word is not merely descriptive of applicant's goods or services. Norwich Pharmacal v. Chas. Pfizer, 165 USPQ 644, 646 (TTAB 1970); In re October Co., Inc., 177

USPQ 276 (TTAB 1973). See also 1 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 11:33 at page 11-57 (4th ed. 1998).

Because the "woman surfer" meaning of the word "wahine" is obscure, we find that applicant's mark WAHINE MAGAZINE is not merely descriptive of "magazines for women in the field of water athletics, namely surfing, and including health and beauty information." Moreover, to the extent there is doubt on the issue of mere descriptiveness, said doubt is resolved in applicant's favor. In re Gourmet Bakers, 173 USPQ 565 (TTAB 1972). Accordingly, the refusal to register on the basis of mere descriptiveness is reversed.

However, we find that the Examining Attorney is correct in her contention that applicant's proposed amended identification of goods is clearly broader than its original identification of goods which was just recited in the preceding paragraph. Accordingly, applicant's proposed amended identification of goods is unacceptable. In re Swen Sonic Corp., 21 USPQ2d 1794 (TTAB 1991).

However, because the Examining Attorney never objected to applicant's original identification of goods, and because the Examining Attorney never accepted applicant's proposed amended identification of goods, the application

currently stands with the identification of goods reading as originally proposed, namely, "magazines for women in the field of water athletics, namely surfing, and including health and beauty information."

Decision: The refusal to register on the basis that applicant's mark is merely descriptive of applicant's goods as originally identified is reversed. Applicant's mark WAHINE MAGAZINE will be passed to publication with the identification of goods reading as originally set forth, namely, "magazines for women in the field of water athletics, namely surfing, and including health and beauty information."

E. W. Hanak

B. A. Chapman

H. R. Wendel
Administrative Trademark
Judges, Trademark Trial and
Appeal Board

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